

Application No.: 10/501126
Docket No.: BA9297USPCT

Page 8

REMARKS

I.

The Office Action indicated that the Restriction Requirement for this application was made final. In light of the requirement, claims 3, 12, 14 and 16 have been canceled, without prejudice, and claim 1 and 6 have now been amended to require a (b2) compound. Claim 18 has also been amended and is now an independent claim. Although certain language relating to (b1), (b3), (b4), (b5), (b6), (b7), (b8) and (b9) has been deleted from Claim 18 itself, Applicants note that new Claim 23 has been added. New claims 24 through 28 have also been added, and as recited therein specifically relate to synergy. With regard to Applicants' request for reconsideration of the restriction requirement insofar as it pertained to Claim 7, the Office Action suggested that including in the composition at least one compound selected from (b1), (b3), (b6), (b7), (b8) and (b9) in addition to at least one compound selected from (b2) constitutes a separate technical feature.

Applicants submit that the test for unity is not whether a separate technical feature is presented, but whether there is a common technical feature. It does not matter if a dependent claim itself contains a further invention. In this case, as noted in Applicants' request for reconsideration, there is a common technical feature shared by the Group II claims under examination and Claim 7. In other words, the combination addressed in Claim 7 includes all the features of the subcombination of Claim 1 from which it indirectly depends (insofar as Claim 1 relates to Group II). Subject to Rule 13.1 it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention. (see MPEP 1850 and Rule 13.4). Accordingly, Applicants submit that prior to examination on the merits no dependent claim should be considered to lack unity with the Group II independent claim from which it depends so long as it shares the technical feature of Group II; and that that even where an objection of lack of unity between all of the claims dependent on an independent claim that does not avoid the prior art may arise a posteriori, an opportunity should be afforded to select among the dependent claim groups that do not have an inventive link. In sum, Applicants maintain the objection to the restriction requirement insofar as it relates to dependent claims such as Claim 7 that share the technical feature of Group II, and respectfully request further reconsideration of Claim 7 and other such claims.

Application No.: 10/501126
Docket No.: BA9297USPCT

Page 9

Applicants submit that amended Claim 18, now an independent claim, and new Claim 24 clearly should be included in the Group II claims under examination, and that all of the claims that depend directly or indirectly from these independent claims should also be considered.

II.

In the Office Action claims 1, 2, 4-11 and 17 were rejected as unpatentably obvious under 35 U.S.C. 103(a) based on consideration of U.S. Patent 6,503,933 to Moloney et al. in light of U.S. Patent 6,503,933 to Berezna et al. and a Jordan et al. article entitled "mode of action of famoxadone". The Office Action maintained that Moloney et al. discloses component (a) compounds such as 2,6-dichloro-*N*-[[3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl]benzamide, Berezna et al. discloses famoxadone as an "agricultural protectant" that can be mixed with certain fungicidal pyrimidinones, and that Jordan et al. discloses that famoxadone is an inhibitor of mitochondrial transport, specifically inhibiting the function of the enzyme ubiquinol:cytochrome c oxidoreductase (cytochrome bc1). The Office Action suggested that it would have been obvious to use 2,6-dichloro-*N*-[[3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl]benzamide as taught by Maloney et al. and combine it with an "agricultural protectant" famoxadone, as taught by Berezna et al. because Moloney et al. teaches (col. 3, lines 29-32) that the compositions therein can include additional active ingredients (e.g., compounds known to possess fungicidal properties) and Berezna et al. teaches (col. 68, lines 58-64) the advantage of combining compounds with fungicidal properties as having an even broader spectrum of agricultural protection.

Applicants submit that Col. 68, lines 58-64 of Berezna et al. does not suggest combining famoxadone, or any other (b2) compound, with a component (a) compound; and that instead this disclosure is limited to a discussion of combinations including certain fungicidal fused-ring pyrimidinones that are not structurally related to component (a) compounds of the present invention that include both a substituted pyridinyl ring and a substituted phenyl ring that are structurally separated from each other. Applicants further submit that while Col. 3, lines 29-32 of Moloney et al. indicates generally that the compositions can comprise other actives, it does not specifically disclose famoxadone or any other (b2) compound or suggest that (b2) compounds should be combined. Moreover, Applicants submit that Moloney et al. does not disclose or fairly suggest that combinations with (b2) compounds will provide advantageous results as disclosed by Applicants.

In particular, Applicants note that certain combinations of component (a) compounds and (b2) compounds have been illustrated to exhibit synergy (see Table A). As noted above, new claims 24 through 28 have been added and as recited therein specifically relate to synergy.

Application No.: 10/501126
Docket No.: BA9297USPCT

Page 10

III.

In the Office Action claims 1, and 4-11 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6-9, 11-14 of copending application No. 10/501,122 and over claims 1, 6-9, and 11-14 of copending application No. 10/501,853. The Office Action suggested that there are certain similarities in the "core" of the compounds.

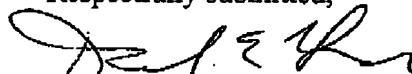
Applicants submit that the Office Action provides no basis for the suggestion that the groups other than the so-called "core" included in the respective compounds cannot be a basis of patentable distinction. Indeed, Applicants note that Groups XI and XII of the present restriction requirement were considered by the Examiner as separate inventive concepts despite having similar "cores".

In any event, Applicants submit that this application may be forwarded on to allowance in light of the status of application Nos. 10/501,122 and 10/501,853.

Claims 8 and 10 have been canceled without prejudice to limit the total number of pending claims to twenty.

In view of the foregoing, allowance of the above-referenced application is respectfully requested

Respectfully submitted,



DAVID E. HEISER

ATTORNEY FOR APPLICANTS

Registration No.: 31,366

Telephone: (302) 892-1926

Facsimile: (302) 892-7949

Dated: September 19, 2007

T:\Patent Documents\Ag Products\BA-92xx\BA-9297\US PCT\US PCT - AMENDMENT 2.doc